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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/752,195	01/05/2004	Steve Hsieh	CONTENDER01	4056

7590 04/04/2006

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EXAMINER

STASHICK, ANTHONY D

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/752,195

Applicant(s)

HSIEH, STEVE

Examiner

Anthony Stashick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112 and Claim Rejections - 35 USC § 101

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 14-15 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either an asserted utility or a well established utility because applicant has only recited a series of abstract ideas without an practiced application. Applicant has only given a step that does not provide a practical application such as a physical transformation or production of a useful, concrete and tangible result.

Claims 14-15 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a known asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang 5,832,633 in view of Watanabe et al. 5,667,857 and Fernyhough et al. 5,935,508. Wang '633 teaches that a toecap for footwear can be made up of layers of material that have composite fibers located along different directions and at different angles to each other. Watanabe et al. '857 teaches that the layers of fibrous material can be made of material with a continuous strand (see col. 2, line 34). Fernyhough et al.

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'508 teaches that a strand used in making a fibre-reinforced composition can be impregnated before weaving that fiber into a mat. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the reinforced layered toe cap of Wang '633 out of layers with the strand acting at different angles to the longitudinal line of the foot, out of a continuous strand material, as taught by Watanabe et al. '857 to provide strength to the toe cap in multiple directions. Furthermore, it would have been obvious to make the continuous strand material out of impregnated fibers, as taught by Fernyhough et al. '508 to keep the layer as thin as possible to prevent build-up in the front of the user's shoe under their toe. With respect to claim 2, Wang '633 teaches the placing of the different fiber layers in a layer-specific orientation. With respect to claim 3, see Figure 2 of Wang '633. Claim 4's limitations can also be seen in Figure 2 with respect to lead lines 12 and 13. With regards to claim 5, Watanabe et al. '857 teaches the making of a toecap by molding a sheet into form, thereby including a sheet molding compound as well as resin to hold the layers together. With respect to claims 11-13, the use of glass fibers, directions continuous reinforcing roving and directional continuous woven cloth made out of yarns are well known reinforcements used to reinforce materials to add strength while maintaining shapeability.

5. Claims 7-10 are rejected under 35 U.S.C. 103(a) as being obvious over the references as applied above. The references as applied above disclose all the limitations of the claims except for specific resins. The resins listed in claims 7-10 are known resins that are used throughout the industry to adhere layers of material together. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to use vinyl ester, polyester, epoxy or polyurethane between the layers of the references as applied above to aid in holding the layers together and strengthening the structure.

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Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are cited on form 892 enclosed herewith.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561. The examiner can normally be reached on Monday through Thursday from 8:30 am until 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anthony Stashick
Primary Examiner
Art Unit 3728

ADS